



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takanori MASUI et al.

Group Art Unit: 2137

Application No.: 10/653,216

Examiner: S. GELAGAY

Filed: September 3, 2003

Docket No.: 116970

For: DATA SECURITY IN AN INFORMATION PROCESSING DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

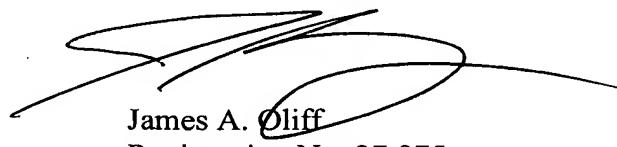
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the March 24, 2008 Final Rejection and July 8, 2008 Advisory Action is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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REMARKS

Claims 2-13, 15, 16 and 18-28 are pending in this application.

The Office Action rejects claims 2-4, 15, 19, 20, 24, 26 and 27 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2003/0219127 to Russ et al. (hereinafter "Russ") in view of U.S. Patent No. 7,093,295 to Saito; rejects claims 11-13 and 18 under 35 U.S.C. §103(a) over Russ in view of U.S. Patent No. 5,677,952 to Blakley III; rejects claim 16 under 35 U.S.C. §103(a) over Russ in view of Saito and U.S. Patent No. 5,805,706 to Davis; rejects claims 5-10 under 35 U.S.C. §103(a) over Russ in view of Saito and Blakley III; and rejects claims 21-23, 25 and 28-30 under 35 U.S.C. §103(a) over Russ in view of Saito and U.S. Patent Application Publication No. 2002/0184518 to Foster et al. (hereinafter "Foster"). These rejections are respectfully traversed.

Claim 19 recites, among other features, a deciding device for deciding whether the input data is encrypted, whether to store the input data and whether to encrypt data decrypted by the decryption module, the deciding device (1) decides based on a job classification information of the input data that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data, and (2) instructs to execute a print process associated with the inputted data after deciding that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data. Claim 20 recites, among other features, deciding whether the input data is encrypted, whether to store the input data and whether to encrypt data decrypted by the decryption module; deciding based on a job classification information of the inputted data that the data encrypted by the decryption module is to be printed without the encryption module encrypting the data; and instructing to execute a print process associated with the inputted data after deciding that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data.

The applied references cannot reasonably be considered to have suggested such combinations of features for at least the following reasons.

The Office Action asserts that Russ and Saito do not teach the deciding device (1) decides based on a job classification information of the input data that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data, and (2) instructs to execute a print process associated with the inputted data after deciding that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data, as recited in claim 19. The Office Action does not apparently specifically address the similar features recited in claim 20. To cure the deficiencies, the Office Action applies Foster. Foster, however, does not teach, nor can it reasonably be considered to have suggested, at least the above-quoted features recited in claim 19, and those of claim 20.

For example, the Office Action asserts that Foster teaches features that allegedly correspond to these features in paragraphs [0096]-[0099]. In paragraphs [0096]-[0099], Foster teaches that the job ticket service controls job content access, updates job ticket as processes are completed, completes the job ticket and reports when all processes are completed for a specific job ticket. Foster, however, does not disclose, (1) decides based on a job classification information of the input data and (2) instructs to execute a print process associated with the inputted data after deciding that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data, as recited in claim 19, and similarly recited in claim 20.

The Advisory Action paraphrases and mischaracterizes the above argument. Specifically, the Advisory Action does not address how any of the applied references are alleged to disclose decides based on a job classification information of the input data that the data decrypted by the decryption module is to be printed without the encryption module encrypting the data. Applicants maintain that none of the applied references can reasonably

be considered to have disclosed or suggested such features. In other words, the references failed to disclose specifically what is being decided as recited in claims 19 and 20.

Additionally, Russ, Saito and Foster are not combinable in the manner suggested by the Office Action. Russ is directed to a master-receiver and a subscriber television network that receives service instances (Abstract). Saito is directed to a re-encryption apparatus for ensuring protection of digital data (Abstract). In contrast, Foster, as discussed above, is directed to a job ticket service. Foster, however, only uses an authorization infrastructure in the context of preventing processors from accessing bids and information from any other processor in the context of the job ticket structure. It is unreasonable to assert that one of ordinary skill in the art would have obviously combined Foster with Russ and Saito in the manner suggest to achieve a predictable result at least because Foster does not contemplate the decryption and encryption analysis disclosed by either Russ or Saito, and certainly not the sophisticated structure recited in the pending claims. Further, for at least this reason, one of ordinary skill in the art would not have had a reasonable expectation of success in combining the references in the manner suggested.

The Office Action's conclusory statement regarding combining Russ, Saito and Foster to allow users to generate specific tasks and to control the requested task accordingly does not meet the articulated standard required to demonstrate obviousness. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). See also the Supreme Court's reasoning in *KSR v. Teleflex*, requiring explicit "articulated reasoning with a rational underpinning" to support a legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (2007), citing *In re Khan* 441 F.3d 997, 998 (Fed. Cir. 2006). This standard is not met here as no

articulated reasoning with some rational underpinning is provided in order to meet the standard of obviousness required by the judicial precedent for combining these references in the manner suggested. In particular, the Office Action's asserted motivation to allow users to generate specific tasks and to control the requested task accordingly is without consideration of the differences between the disclosures of the applied references, as discussed above.

For at least the foregoing reasons, the applied references do not teach, nor can they reasonably be considered to have suggested, the combinations of all of the features positively recited in independent claims 19 and 20. Additionally, claims 2-13, 15, 16, 18 and 21-28 are also not taught, nor would they have been suggested, by the applied references for at least the respective dependence of these claims, directly or indirectly, on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of 2-13, 15, 16 and 18-28 under 35 U.S.C. § 103(a) as unpatentable over the applied references are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of 2-13, 15, 16 and 18-28 are earnestly solicited.